

**DETAILED ACTION**

***Election/Restrictions***

1. This application contains claims drawn to an invention nonelected with traverse in the reply filed on 7/18/08. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 112, 1st Paragraph***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 and 22-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, said claims appear to call for allowing the activated carbon to absorb caffeine after the step of removing the precipitate and activated carbon by filtration. The original specification does support allowing the activated carbon to absorb caffeine wherein same is then removed along with the precipitate using filtration. It appears that Applicant may have intended to reverse the order of the last two steps in each of the independent claims. This would coincide with what is set forth in the original specification. This is a new matter rejection.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 15-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-19 and 22-25 of copending Application No. 10/581200. Although the conflicting claims are not identical, they are not patentably distinct from each other because, for example, same vary slightly in the amount of caffeine containing catechin composition (e.g. green tea extract) per mixed solution or mixture as well as a difference in range (though overlapping) of the amount of non-polymer catechins contained in said composition. However, such differences are not seen as providing a patentable distinction, and it would have been obvious to one having ordinary skill in the art at the time of the

invention to have modified the ratios of 10/581200 slightly as a matter of preference depending on, for example, the amount of each component readily available. In addition, the instant claims further recite steps of removing impurities (undissolved solids) and the solvent used. However, it would have been obvious to have included such step in the process claims of 10/581200 since providing same would provide better isolation of or purification of the catechin composition for subsequent consumer use. Otherwise, the instant claims essentially are generic to those of copending Application no. 10/581200. In particular, the claims of 10/581200 recite a process of removing caffeine using a particular ratio of green tea extract containing caffeine with a mixture of organic solvent, water, activated carbon and acid clay or activated clay. The instant claims are generic to same as they provide for treatment of any caffeine containing catechin source.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-10 and 22-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-19 and 22-25 of copending Application No. 10/581200 taken together with JP 2002-153211.

The claims of 10/581200 are silent regarding how the activated charcoal would be removed from the tea extract. JP 2002-153211 teaches a similar process wherein activated carbon is added to a tea extract for removal of caffeine. However, JP 2002-153211 further teaches said activated carbon then being removed from the tea extract by filtering same (see Example). It would have been obvious to one having ordinary

skill in the art at the time of the invention to have employed such teaching as matter of preference among known steps for removing activated carbon from a tea extract.

It is inherent that the acid clay would be separated from the tea extract to fulfill the removal of components from the tea extract. In addition, using the information of Jp 2002-153211, one skilled in the art would realize such step of removing a solid from a liquid extract using filtration would apply as well to other solids such as acid clay. It would have been further obvious to have incorporated such removal step to include not only the removal of activated carbon but also acid clay to provide more processing efficiency.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 46-39058 taken together with Hara.

JP 46-39058 discloses a process wherein a caffeine-containing catechin composition (e.g. green tea) is treated in a mixture of water and organic acids (e.g. ethanol) wherein same is then treated with activated charcoal (i.e. activated carbon) same inherently selectively removing caffeine. JP 46-39058 further discloses the steps

of distilling of the solvent as well as further purifying the treated composition (inherently including removal of undissolved solids). See Abstract.

The claims further call for the particular percentage of organic solvent to water. Regarding the latter, JP 46-39058 does not appear to disclose the specific organic solvent to water used. However, it is well known in the art to use a solvent solution of between 40 and 75% ethanol (which falls within the range claimed) to effectively extract catechins from tea extracts as taught, for example by Hara et al (col. 2). It would have been obvious to one having ordinary skill in the art at the time of the invention to have employed such water to solvent ratio to effectively extract catechins from the extract of JP 46-39058. It is noted that the instant invention calls for removing caffeine from catechin compositions (e.g. tea). However, the steps employed in JP 46-39058 (along with the solvent ratio of suggested by Hara) are essentially those employed in the instant invention. Therefore, it is inherent that caffeine would be effectively removed from the tea extract as well.

Due to the similarity in processing, it is considered inherent that the extract attained would have a non-polymer catechin to caffeine ratio as called for in instant claim 10 and the particular product limitations as set forth in claim 18.

The claims further call for the non-polymer catechin content of the caffeine-containing catechin composition. Absent a showing of unexpected results, the determination of the most effective particular solids content and/or catechin content of the tea source would have been further obvious through routine experimental optimization.

8. Claims 1, 3, 5-10, 22, 25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 46-39058 taken together with Hara and JP 2002-153211.

JP 46-39058 has been discussed above.

It is inherent in JP 46-39058 that the activated charcoal would be removed from the tea extract to fulfill the action of removing caffeine altogether from the tea extract. However, JP 46-39058 appears to be silent regarding how this is achieved. JP 2002-153211 teaches a similar process wherein activated carbon is added to a tea extract for removal of caffeine. However, JP 2002-153211 further teaches said activated carbon then being removed from the tea extract by filtering same (see Example). It would have been obvious to one having ordinary skill in the art at the time of the invention to have employed such teaching as matter of preference among known steps for removing activated carbon from a tea extract.

9. Claims 2, 4-10, and 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 46-39058 taken together with Hara, JP 2002-153211, and JP 6-128168.

The claims further call for the use of acid clay in combination with activated carbon. As both are known for removal of impurities from tea extracts as taught, for example, by JP 6-128168, it would have been obvious to one having ordinary skill in the art at the time of the invention to have employed both singly or in combination to provide the same benefit. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Kerkhoven, 205

USPQ 1069.

It is inherent that the acid clay would be separated from the tea extract to fulfill the removal of components from the tea extract. In addition, using the information of JP 2002-153211, one skilled in the art would realize such step of removing a solid from a liquid extract using filtration would apply as well to other solids such as acid clay. It would have been further obvious to have incorporated such removal step to include not only the removal of activated carbon but also acid clay to provide more processing efficiency.

#### ***Response to Arguments***

10. Applicant's arguments filed 3/22/10 have been fully considered, and the previously applied rejection under 35 USC 112 has been overcome. In addition, the amendments of the claims to make clear what the ratio is based on makes JP 6-128168 no longer applicable as prior art. All other arguments are not persuasive and are addressed below, in the rejections above, or in previous Office Actions (e.g. declarations).

Applicant argues that Hara is not relevant to the instant invention as same uses the ethanol aqueous solution for the extraction of tea catechins from tea leaves which applicant further argues is mixed solution of the instant invention used to dissolve a solid caffeine-containing catechin composition. The examiner disagrees in view of the instant claims as presently recited. In particular, the instant claims call for "dissolving...solid caffeine-containing catechin composition in a mixed solution comprising ethanol and water" (e.g. claim 1). JP 46-39058 discloses a process wherein

material from the tea leaves is dissolved as an extract into a solution of ethanol and water. The material that is dissolved into the ethanol and water is a solid as it originates from the tea leaf. In addition, the material that is dissolved into said solution is a "caffeine-containing catechin composition". It is inherent that caffeine and catechin material would be removed with the ethanol and water mixture. Hara further provides evidence of same. By using a similar process (alcohol and water mixture put into contact with tea leaves), Hara teaches that both catechins and caffeine are removed (col. 2, lines 40 and 49) into the resulting extract. Said catechins and caffeine (as well as all other components extracted from the tea leaves) make up a composition, a caffeine-containing catechin composition. Because Hara and JP 46-39058 both treat tea in a similar manner, same are clearly analogous art, and it is reasonable to employ the teachings of Hara (in particular, the ratio of solvent to water in removing components

All other arguments have been addressed in view of the rejection above.

### **Conclusion**

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not



mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Anthony Weier  
Primary Examiner  
Art Unit 1794

/Anthony Weier/  
Primary Examiner, Art Unit 1794

Anthony Weier  
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